

The opinion in support of the decision being entered today was
not written for publication and is not binding precedent of the
Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ERIK BROGAARD THOMSEN

Appeal No. 2004-1306
Application No. 09/381,771

MAILED

JUN 21 2004

U.S PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

ON BRIEF

Before WARREN, OWENS, and DELMENDO, Administrative Patent
Judges.

DELMENDO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 (2003) from the examiner's final rejection of claims 9 through 17 (final Office action mailed Apr. 9, 2002, paper 10), which are all of the claims pending in the above-identified application.

The subject matter on appeal relates to "[a]n advertisement print being printed on a plane print carrier." Further details

of this appealed subject matter are recited in representative claim 9 reproduced below:

9. An advertisement print being printed on a plane print carrier, and which print is plane and lies in the same plane as the print carrier and comprises a primary figurative element depicting an advertisement in a first dimension and a second dimension, which primary figurative element when seen in a direction perpendicular to the plane of the print carrier constitutes an angle $\alpha+90^\circ$ between the first dimension and the second dimension, and which primary figurative element when seen in a given oblique direction between a viewer and the print shows a first dimension and the second dimension as forming a plane of advertisement, which plane of advertisement is directed obliquely outwards of the plane of the print carrier, wherein the advertisement print comprises a secondary figurative element depicting the advertisement in a third dimension, that the secondary figurative element when seen in a direction perpendicular to the plane print carrier constitutes an angle $\alpha+\beta$ between the first dimension and the third dimension and an angle $\beta+90^\circ$ between the first [sic] dimension and the third dimension and which secondary figurative element when seen in the given oblique direction between the viewer and the print shows the third dimension as directed perpendicular to the plane of advertisement being formed by the first and the second dimension and that the angles α , β are different from 0° .

17. An advertisement print according to claim 9, wherein the plane print carrier is a vertical surface.

The examiner relies on the following prior art references as evidence of unpatentability:

Rusin 5,941,002 Aug. 24, 1999
(filed Apr. 02, 1997)

Blue Knot Software, B/W Fontworks, at
<http://www.revealed.net/bwsoft/fonts.html> (published Jun. 07,
1997) (hereinafter "Fontworks").¹

Claims 9 through 17 on appeal stand rejected under 35 U.S.C. § 101 as lacking "patentable utility." (Examiner's answer mailed Mar. 11, 2003, paper 15, page 3.) Also, claims 9 through 15 on appeal stand rejected under 35 U.S.C. § 102(b) as anticipated by Fontworks.² (Id. at pages 4-5.) Further, claims 16 and 17 on appeal stand rejected under 35 U.S.C. § 103(a) as unpatentable over Fontworks in view of Rusin. (Id. at page 5.)

We reverse the 35 U.S.C. § 101 rejection but affirm the rejections under 35 U.S.C. §§ 102 and 103(a) for the reasons well stated in the answer.³

35 U.S.C. § 101: Claims 9-17

The examiner's position is that "the invention simply constitutes an abstract idea, text on a surface and as such does

¹ See http://web.archive.org/web/*/http://home.revealed.net/bwsoft/fonts.html, copy attached.

² Although the examiner indicates that Fontworks is available as prior art under 35 U.S.C. § 102(b), we note that the reference is actually available as prior art under 35 U.S.C. § 102(a).

³ The appellant submits that the appealed claims stand or fall together for each ground of rejection. (Appeal brief filed Dec. 16, 2002, paper 12, p. 4.) Accordingly, for the §102(b) rejection, we select and confine our discussion to claim 9. For the §103(a) rejection, we select and confine our discussion to claim 17. 37 CFR § 1.192(c)(7)(2002) (effective Apr. 21, 1995).

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not present subject matter for which a utility patent may be obtained." (Answer, page 3.) In support of this position, the examiner relies on State Street Bank & Trust Co. v. Signature Financial Corp., Inc., 149 F.3d 1368, 1373, 47 USPQ2d 1596, 1600-1601 (Fed. Cir. 1998).

We cannot agree with the examiner on this issue. 35 U.S.C. § 101 extends to "anything under the sun that is made by man." Diamond v. Chakrabarty, 447 U.S. 303, 309 (1980); see also Diamond v. Diehr, 450 U.S. 175, 182 (1981).

In this case, the appealed claims are directed to an advertisement print having the specified figurative elements thereon for the purpose of imparting a certain visual effect to an observer viewing the advertisement print from a certain perspective. (Specification, "Background of the Invention.") Thus, the invention recited in the appealed claims involves more than merely an abstract idea that does not produce "a useful, concrete and tangible result." State Street, 149 F.3d at 1373, 47 USPQ2d at 1600-1601.

Accordingly, we cannot uphold the examiner's rejection on this ground.

35 U.S.C. § 102: Claims 9-15

To aid us in determining whether the examiner applied the prior art correctly against the appealed claims, we must first

consider the scope and meaning of certain terms that appear in representative claim 9. Gechter v. Davidson, 116 F.3d 1454, 1457, 1460 n.3, 43 USPQ2d 1030, 1032, 1035 n.3 (Fed. Cir. 1997); In re Paulsen, 30 F.3d 1475, 1479, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994). It is well settled that, in proceedings before the United States Patent and Trademark Office (PTO), claims in an application are to be given their broadest reasonable interpretation, taking into account the written description found in the specification. In re Morris, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); In re Zletz, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) ("During patent examination the pending claims must be interpreted as broadly as their terms reasonably allow."); In re Yamamoto, 740 F.2d 1569, 1571, 222 USPQ 934, 936 (Fed. Cir. 1984) ("The PTO broadly interprets claims during examination of a patent application since the applicant may 'amend his claim to obtain protection commensurate with his actual contribution to the art.'") (quoting In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550 (CCPA 1969)).

Appealed claim 9 recites the terms "advertisement," "primary figurative element," and "secondary figurative element." Neither the claim nor the specification places any limitation on the actual content of the advertisement or the

figurative elements. Under these circumstances, we determine that one skilled in the relevant art would understand appealed claim 9 to encompass any pair of figurative elements satisfying the recited characteristics with no limitation whatsoever as to textual content. Also, the angles recited in appealed claim 9 do not specify any reference object or portion of the figurative elements, and therefore one skilled in the relevant art would understand these angles to refer to any angle created by any portion of the figurative elements. Further, the term "comprises" indicates to one skilled in the relevant art that the advertisement print may contain other unrecited characters or figurative elements.⁴

We share the examiner's view that Fontworks describes each and every limitation of the invention as broadly recited in appealed claim 9. For example, the "y" in the "Sanity Font Family" or any of the characters of the "Glory Font Family" satisfies the requirements recited in appealed claim 9. Like the claimed invention, the characters shown in Fontworks include "a primary figurative element" (i.e., the face portion) which can be considered to depict "an advertisement" having the here

⁴ In claim drafting, the term "comprises" not only alerts potential infringers that the recited components are essential, but that other unrecited components may be included and still

recited characteristics. Furthermore, the characters include "a secondary figurative element" (i.e., the portions of a character behind the face portion) that may be considered to depict "an advertisement" having the here recited characteristics.

Accordingly, we determine that Fontworks describes each and every limitation of the invention recited in appealed claim 9.

The appellant argues that the print described in Fontworks does not satisfy the limitations of the claimed invention.

(Appeal brief, pages 7-8.) The appellant's arguments, however, ignore or overlook the broad scope of appealed claim 9. As we stated above, the "y" of the "Sanity Font Family" or any of the characters of the "Glory Font Family" anticipates the invention recited in appealed claim 9. While the appellant relies on certain exhibits attached to the reply brief filed May 9, 2003 (paper 16) to establish a difference between the claimed invention and the prior art, the appellant fails to take into account the broad scope of appealed claim 9.

35 U.S.C. § 103(a): Claims 16 and 17

With respect to appealed claim 17, the appellant relies on the same arguments made against appealed claims 9-15. (Appeal

form a construct within the scope of the claim. See, e.g., In re Baxter, 656 F.2d 679, 686, 210 USPQ 795, 802 (CCPA 1981).

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brief, pages 8-9.) Accordingly, we affirm this ground of rejection for the same reasons discussed above.

Summary

In summary, we reverse the examiner's 35 U.S.C. § 101 rejection of appealed claims 9 through 17 as lacking "patentable utility." We affirm, however, the examiner's 35 U.S.C. § 102 rejection of appealed claims 9 through 15 as anticipated by Fontworks and the 35 U.S.C. § 103(a) rejection of appealed claims 16 and 17 as unpatentable over Fontworks in view of Rusin.

The decision of the examiner is therefore affirmed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED



Charles F. Warren)
Administrative Patent Judge)

) BOARD OF PATENT

Terry J. Owens)
Terry J. Owens)
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) APPEALS AND

) INTERFERENCES



Romulo H. Delmendo)
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